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PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicants: Robertson, S.
Serial No.: 09/324,601
Appeal No.: 2007-1813
Title of Invention: System and Method for Providing Electronic Multi-Merchant Gift Certificate and Contribution Brokering Services Over a Distributed Network
Filing Date: 06/02/1999
Group Art Unit: 3625
Examiner: Fadok, M.
Attorney Docket No.: ROBERT.P001

Seattle, Washington 98109
October 18, 2007

Mail Stop Patent Appeals - Request for Rehearing
COMMISSIONER FOR PATENTS
PO Box 1450
Alexandria, VA 22313-1450

REQUEST FOR REHEARING - TC 3600

It is respectfully requested that the decision by the Board of Patent Appeals and Interferences (Board) dated August 20, 2007 in the above identified application (Ex parte Robertson, Appeal No. 2007-1813 before Murriel E. Crawford, Anton W. Fetting, and David B. Walker) be reheard on the written record.

In the sole rejection before the Board on appeal, claims 23-37, the only claims pending in the application on appeal, stood rejected under 35 U.S.C. § 102(e) as anticipated by Gillin, US 7,010,512 B1.

The Board regarded Claim 23 as exemplary of the claims and reproduced it in their decision, and it is also reproduced here, with the Board's own paragraphing added. Applicant adopts this style for this Request for the sake of continuity with the Board's own discussion and remarks.

EXPRESS MAIL CERTIFICATE (37 C.F.R. § 1.10)

I hereby certify that this correspondence, together with all papers and fees listed as attached or enclosed, are being deposited on the date indicated herein with the United States Postal Service "Express Mail Post Office to Addressee" service Express Mail #EV956121724US with sufficient postage, addressed to the Commissioner of Patents and Trademarks, PO Box 1450, Alexandria, VA 22313-1450.

October 18, 2007

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23. A system for providing an electronic gift certificate service for users over a distributed network, comprising:
- [1] a plurality of merchant sites connected to the distributed network, each merchant site running at least one application to provide an online service to users over the distributed network;
 - [2] a plurality of user computers connected to the distributed network, each user computer running at least one application to access the online service at a merchant site;
 - [3] a gift certificate authority site connected to the plurality of merchant sites, the gift certificate site including
 - [a] a user database and
 - [b] a merchant database, each database containing authentication information as to respective users and merchants,
 - [c] and a gift certificate database which stores
 - gift certificate data and
 - transaction data
 - related to particular gift certificates,
 - [d] the users accessing the merchant sites from the user computers over the distributed network; and
 - [e] an authentication protocol for allowing the gift certificate site to authenticate users and merchants;
 - [4] whereby
 - [a] a user purchases a gift certificate having a unique gift certificate identification code on the gift certificate authority site for use at a merchant site, and
 - [b] a merchant site processes the gift certificate through the gift certificate database on the gift certificate authority site.

It appears the Board sustained the Examiner's 102(e) rejection over Gillen based at least in part on the following misstatement of what the Board called the issue on appeal. The Board said (page 5, line 5),

The pertinent issue turns on whether Gillin describes a gift certificate site containing merchant, user, and gift certificate databases with authentication information for merchants and users.

ISSUE ON REHEARING

The actual issue in this appeal is not as supposed by the Board. The real issue before the Board, as in every appeal from a 102 rejection, and the issue here on rehearing, is whether the 102 reference teaches all of the claim elements, not just some of them. And it is clear at least in claim 23 that elements 4a and 4b (using the Board's paragraphing) are nowhere suggested or taught in Gillin.

ARGUMENT

Gillin fails to teach or suggest a gift certificate site that is operably capable of the having a user purchasing a gift certificate on the gift certificate authority site [4][a], AND, on the same gift certificate authority site, is also capable of receiving the merchants processing of the gift certificate [4][b].

“[4] whereby

[a] a user purchases a gift certificate having a unique gift certificate identification code *on the gift certificate authority site* for use at a merchant site, and

[b] a merchant site processes the gift certificate through the gift certificate database *on the gift certificate authority site* [Emphasis added].”

In Gillin none of this happens on the same site. The issuing bank does not sell the gift certificate directly to the purchaser and the merchant does not process the gift certificate with the gift certificate site (because what the gift certificate site is really selling is a credit card that it has already bought from an issuing bank).

Element 10 of Figure 3 in Gillin, referred to in Gillin as the “transfer document issuer”, is clearly separate from element 20, referred to in Gillin as the “issuing Bank” and also different from element 212, referred to in Gillin as the “acquiring banks”. Gillin, col. 7, ll. 1-13. But the Board appears to have accepted the Examiner’s position without close reviewing scrutiny of their own. In addition, Figure 1 in Gillin clearly shows the two entities 10 and 20 as separate elements; and note in Figure 3 the dotted lines separating transfer document issuer 10 from the merchant bank processor 238.

Even if the Board could properly equate the issuing/acquiring bank to the gift certificate site, then, in Gillin’s system, we see that the issuing/acquiring bank does not “sell” the credit card to the gift certificate purchaser. If the Board equates the “transfer document issuer” with the gift certificate site, then, in Gillin’s system, we see that the “transfer document issuer” does not receive merchant processing of the purchases made by the gift certificate recipient. In other words, in no scenario or extrapolation of the teachings of Gillen, do we find a teaching that user gift certificate purchasing and merchant processing of that same gift certificate happen on the same site, as absolutely required by claim 23’s elements 4a and 4b.

Again, what is critical here, as always, is that for a 102 reference to be effective, it must teach all of the claim elements, not just some of them. And elements 4a and 4b are not taught in Gillin; indeed they cannot be, for, as shown clearly here, Gillin teaches a completely different system which is just not consistent with what Applicant discloses and claims.

Appellant claims that gift certificates are purchased on the Gift Certificate Authority Site (see Appellant’s application, Figures 3-6) AND that merchants process those same gift certificates on the same Gift Certificate Authority Site (see Appellant’s application, Page 10, paragraph 3 - “Merchant sites 60 communicate with the Gift Certificate Authority 80 to authenticate the gift certificates and to redeem the certificates on the user’s behalf.”)

In rehearing reversal of the Examiner’s rejection of claim 35, Applicant relies (without acquiescence) on the Board’s reasoning, namely “As the Examiner found, claim 35 is essentially the same as claim 23 with the word ‘beneficiary’ replacing ‘merchant’ and the word ‘contribution’ replacing the phrase ‘gift certificate’ ... Since both claims are system claims, the structure is identical

and therefore the finding that Gillin anticipates claim 23 necessarily means that it also anticipates claim 35 (Board decision, page 16, lines 17-23)." Appellant therefore asserts that if Gillin does not anticipate claim 23, as is argue above, then it necessarily follows that Gillin also does not anticipate claim 35.

CONCLUSION

Therefore, it is respectfully requested that the Board decision of August 20, 2007 in the above-identified application be reconsidered, and that the rejection of claims 23-37 under 35 U.S.C. § 102(e) be reversed, since none of the appealed claims are anticipated by Gillin.

The claims on appeal are again set forth in the attached Appendix.

Respectfully submitted,



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CLAIMS APPENDIX

Claims on Appeal:

1-22. Cancelled.

23. A system for providing an electronic gift certificate service for users over a distributed network, comprising:

a plurality of merchant sites connected to the distributed network, each merchant site running at least one application to provide an online service to users over the distributed network;

a plurality of user computers connected to the distributed network, each user computer running at least one application to access the online service at a merchant site;

a gift certificate authority site connected to the plurality of merchant sites, the gift certificate site including a user database and a merchant database, each database containing authentication information as to respective users and merchants, and a gift certificate database which stores gift certificate data and transaction data related to particular gift certificates, the users accessing the merchant sites from the user computers over the distributed network; and

an authentication protocol for allowing the gift certificate site to authenticate users and merchants;

whereby a user purchases a gift certificate having a unique gift certificate identification code on the gift certificate authority site for use at a merchant site, and a merchant site processes the gift certificate through the gift certificate database on the gift certificate authority site.

24. The system of claim 23, further comprising, during user purchase of a gift certificate, the user placing restrictions on the use of the gift certificate.

25. The system of claim 23, further comprising tracking use of the gift certificate by the user.

26. The system of claim 25, further comprising a search mechanism operatively associated with the gift certificate database that provides access to the user to those sales transactions associated with a particular user gift certificate.

27. The system of claim 23, further comprising user anonymity that is effected by preventing merchant site access to any user related data, other than the gift certificate identification code.

28. The system of claim 23, further comprising, within the gift certificate database, and in conjunction with merchant site processing of the gift certificate through the gift certificate database, splitting of the gift certificate across multiple purchases at a plurality of merchant sites.

29. A method for a user to purchase a gift certificate from an on-line gift certificate service, the method comprising the steps of:

user enters a desired dollar amount to be applied to the gift certificate;

user enters a user-selected personal identification number (PIN) for authentication in a gift certificate redemption process;

user provides payment information to the gift certificate site for purchasing the gift certificate;

gift certificate site validates user payment information; and

user receives an gift certificate order confirmation, including a unique gift certificate identification code.

30. The method of claim 29 further comprising, ahead of the step of gift certificate site validation, the user associates a fixed shipping address with the gift certificate.

31. The method of claim 29 further comprising, ahead of the step of gift certificate site validation, the user associates a restriction on certificate use, the restriction selected from the group of restrictions consisting of restriction on certificate use by category of product or service, restriction

on certificate use by age range of product or service, restriction on certificate use by dollar limitations on a per order or per item basis, restriction on certificate use by date of use range, and restriction on certificate use to use at selected merchant sites.

32. The method of claim 31 wherein the restriction on certificate use is a restriction on certificate use by category of product or service.

33. The method of claim 29 further comprising, in the step of gift certificate order confirmation, the user selectively elects either immediate online display of the order confirmation, or later e-mail notification, or both.

34. A method for redeeming a gift certificate from an on-line gift certificate service at a merchant site, the method comprising the steps of:

user elects gift certificate as form of payment for selected goods or services at merchant site;

user enters unique gift certificate identification code and user selected PIN; and

merchant site communicates over distributed network with gift certificate authority site to authenticate the user gift certificate and complete user purchase of selected goods or services.

35. A system for providing an electronic contribution service for users over a distributed network, comprising:

a plurality of beneficiary sites connected to the distributed network, each beneficiary site running at least one application to provide an online service to users over the distributed network;

a plurality of user computers connected to the distributed network, each user computer running at least one application to access the online service at a beneficiary site;

a contribution authority site connected to the plurality of beneficiary sites, the contribution site including a user database and a beneficiary database, each database containing authentication information as to respective users and beneficiaries, and a contribution database which stores

contribution data and transaction data related to particular contributions, the users accessing the beneficiary sites from the user computers over the distributed network; and

an authentication protocol for allowing the contribution site to authenticate users and beneficiaries;

whereby a user makes a contribution having a unique contribution identification code on the contribution authority site for use at a beneficiary site, and a beneficiary site processes the contribution through the contribution database on the contribution authority site.

36. The system of claim 35, further comprising, within the contribution database, and in conjunction with beneficiary site processing of the contribution through the contribution database, the contribution is set up to be selectively one-time or recurring automatic.

37. The system of claim 35, further comprising user anonymity that is effected by preventing beneficiary site access to any user related data, other than the contribution identification code.